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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
AKINTOLA, OLABODE	
ART UNIT	PAPER NUMBER
3691	
MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/767,014	WRIGHT, CARL A.	
	Examiner	Art Unit	
	OLABODE AKINTOLA	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 December 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *10-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

In view of the appeal brief filed on 10/18/2006, PROSECUTION IS HEREBY REOPENED.

New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following options:

(1) File a reply under 37 CFR 1.111 (if this office action is non-final) or a reply under 37 CFR 1.113 (if this office action is final); or,

(2) Initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fees and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in the 37 CFR 41.20 have been increased since they were previously paid, then the appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Alexander Kalinowski/

Supervisory Patent Examiner, Art Unit 3691

Status of Claims

Claims 10-24 are pending. The rejections cited are as stated below:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Here, the state of the law with respect to statutory subject matter eligibility under §101 is evolving and is presently an issue in several cases under appeal at the Federal Circuit with regard to process claims. As presently understood, based on Supreme Court precedent and recent Federal Circuit decisions, [see Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)] a §101 statutory process must (1) be tied to another statutory class (e.g. such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met, a method is not a patent eligible process under §101 and should be rejected as being directed to non-statutory subject matter.

For example, a method claim that recites purely mental steps (e.g. can be performed by mental process or human intelligence alone) would not qualify as a statutory process. To qualify

as a §101 statutory process, the claim should (1) positively recite another statutory class (e.g. thing or product) to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps) or (2) positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state).

As per Claim 10, Examiner asserts that Applicant does not adequately tie his/her steps to another statutory class to qualify as a §101 statutory process. Examiner note that the recitation of a processor implemented method in the preamble does not overcome this rejection. In order to overcome this rejection, the ***critical step(s)*** of claim limitations (in the body of the claims) must be tied to an apparatus, for example a processor.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 10-17, 20 and 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Lynam et al (US 6934372).

Re claim 10: Lynam teaches a method for providing timely information related to usage of an Internet service, the method comprising the steps of: providing measured units of Internet service to one or more users (col. 2, lines 55-65, "time units"); tallying the measured units of Internet service provided to one or more users as the measured units of Internet service are consumed by one or more users (col. 2, lines 55-65); assessing a rate per measured unit of Internet service consumed by one or more users as the measured units are tallied (col. 2, lines 55-65, "monetary rate"); calculating a price associated with the consumed measured units of Internet service by multiplying the tally of measured units of Internet service with the assessed rate (col. 2, lines 55-65); and forwarding, within a close time proximity to the consumption of the measured units of Internet service by one or more users, information via a communication link to a designated location, where the information includes at least one of the tally of the measured unit of Internet service, the assessed rated, and the calculated price (col. 2, lines 55 through col. 3, line 11).

Re claim 11: Lynam teaches an initial step of accessing, by one or more users, a connection device connected to the Internet (col. 2, lines 55 through col. 3, line 11, col. 4, lines 7-11).

Re claim 12: Lynam teaches wherein the connection device further comprises a display device (col. 2, lines 55 through col. 3, line 11, col. 4, lines 7-11).

Re claim 13: Lynam teaches wherein the display device further comprises a telephone (col. 2, lines 55 through col. 3, line 11, col. 4, lines 7-11).

Re claim 14: Lynam teaches wherein the telephone utilizes wireless technology (col. 2, lines 55 through col. 3, line 11, col. 4, lines 7-11).

Re claim 15: Lynam teaches a final step of displaying the forwarded information on the display device accessed by the user (col. 8, lines 12-30, Fig. 3c).

Re claim 16: Lynam teaches wherein the forwarded information further comprises the tally, the assessed rate, and the calculated price associated with the consumed measured units of Internet service (col. 2, lines 55 through col. 3, line 11, col. 4, lines 7-11).

Re claim 17: Lynam teaches wherein the communication link further comprises the Internet (col. 2, lines 55 through col. 3, line 11, col. 4, lines 7-11).

Re claim 20: Lynam teaches wherein the forwarded information further comprising identification of one or more of the users of the Internet services (col. 2, lines 55 through col. 3, line 11, col. 4, lines 7-11).

Re claim 22: Lynam teaches a step of requesting payment of the calculated price for consumed Internet services (col. 2, lines 55 through col. 3, line 11, col. 4, lines 7-11, col. 9, lines 42-63).

Re claim 23: Lynam teaches a step of collecting the calculated price for consumed Internet services (col. 2, lines 55 through col. 3, line 11, col. 4, lines 7-11, col. 9, lines 42-63).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynam

Re claims 18 and 24: Lynam does not explicitly teach the step of purchasing the Internet service prior to providing measured units of Internet service to one or more users; discounting the

calculated price according to a predetermined criterion. Official notice is hereby taken that the concept of providing prepaid internet access; and discounting of calculated price base on various factors (e.g. volume pricing) are old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lynam to include these features for the obvious reason of limiting the user's access to the prepaid amount; and providing an incentive to the user.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lynam in view of Hidem et al (US 5749052).

Re claim 19: Lynam does not explicitly teach wherein the forwarded information further comprises data relating to the purchased Internet service not yet consumed.
Hidem teaches the concept of displaying on a cellular telephone, the cost of previous call to be subtracted from the remaining credit or money available (i.e., the amount of call credit remaining in the cell phone) (col. 13, lines 18-45). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lynam to include this feature as taught by Hidem for the obvious reason of alerting the user of the remaining credit available to the user.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lynam in view of Gage et al (US 5923846)

Re claim 21: Lynam does not explicitly teach a step of estimating an expense associated with a particular Internet service prior to consumption of the particular Internet service. Gage teaches the concept of estimating an expense associated with a download (particular Internet service) prior to consumption of the download (particular Internet service) (col. 16, lines 22-36). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lynam to include this features as taught by Gage for the obvious reason of alerting the user of the cost associated with the download before the actual download.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Murphy (US 6564380) teaches the concept of providing a pricing table to requesting parties to access video feeds (col. 12, line 64 through col. 13, line 48).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Olabode Akintola/
Examiner, Art Unit 3691